

Remarks

Applicants acknowledge that claims 1, 3 and 10 have been found to be free of the prior art.

Claim 11 has been cancelled as a non-elected claim, as suggested by the Examiner. This cancellation is without prejudice to the prosecution of claim 11 in a divisional application.

Objection to the amendment of the sequence listing under 35 U.S.C. §132:

Rejection of claims 2 and 4 under 35 U.S.C. §112, first paragraph, written description

The sequence listing has been previously amended to recite *Homo sapiens* as the source for the nucleic acid sequence and deduced amino acid sequence. This amendment has been objected to, and claims 2 and 4 have been rejected on the basis that the recitation of “human” does not satisfy the written description requirement in the specification as originally filed.

Applicants respectfully traverse both the objection to the amendment of the sequence listing and the rejection of claims 2 and 4. The purpose of the written description requirement is to reasonably apprise one skilled in the art that the inventors had possession of the claimed invention as of the filing date of the application. Applicants draw the Examiner’s attention to the following passages of the specification as filed.

- 1) Page 6, lines 27-29: “BLASTN homology searches only identified approximately 20 human expressed sequence tags (ESTs) which had high homology to RBT1.” (emphasis added) No other species is mentioned.
- 2) Page 7, lines 2-5: “Semi-quantitative analysis has shown that RBT1 is at least ten times more expressed in cell line H661 (cancer cells) than NHBEC (normal cells).” It is well known to those skilled in the art that both of these cell lines are human cell lines. This is also what the “H” in each cell line name refers to. Note also that this sentence refers to expression of RBT1, not to a human homolog of RBT1, as it would if the RBT1 probe was from another species.

- 3) Page 10, lines 11-12: "RBT1 may be overexpressed in various human cell lines to ascertain possible phenotypic effects." (emphasis added)
Logically, the most relevant results in human cells would be provided by human RBT1.
- 4) Page 10, lines 14-16: "Antibodies against RBT1 may be raised for subsequent protein localization experiments in human cells." (emphasis added) Again, logically, the most relevant results would be provided by antibodies raised to human RBT1 protein.

Applicants respectfully submit that these passages, taken together, would reasonably apprise one skilled in the art that the disclosed RBT1 nucleic acid and amino acid sequences are of human origin. Accordingly, Applicants respectfully request that the objection to the amendment of the sequence listing and the rejection of claims 2 and 4 be withdrawn.

Although not required for response to this rejection, Applicants submit herewith the declaration of Dr. Moulay Alaoui-Jamali to demonstrate to the Examiner that the inferences that would be drawn by one skilled in the art from the above-cited passages would be correct. The RBT1 sequences disclosed in the specification are indeed of human origin.

Rejection of claim 6 under 35 U.S.C. §112, second paragraph


Claim 6 has been amended to recite that the method is *in vitro*, as supported in the specification at page 7, lines 26-34. Claim 6 has further been amended to recite that the expression of SEQ ID NO.:1 produces a transcriptional activator protein which increases transcription of the gene. Applicants respectfully submit that these amendments overcome the rejection of claim 5 under 35 U.S.C. §112, second paragraph.

If the Examiner believes that any discussion of this communication would be helpful, the Examiner is invited to contact the undersigned attorney by telephone at 781-933-6630 (direct).

Serial No. 10/069,386
Page Five

Respectfully submitted,

Dated: December 22, 2005



Wayne A. Keown, Ph.D., Reg. 33,923
Keown & Associates
500 West Cummings Park - Suite 1200
Woburn, MA 01801
781-938-1805 (telephone)
781-938-4777 (fax)